

REMARKS

In response to the above Office Action, claims 1, 6, and 11 have been amended to limit the amount of ortho cresol to 1.0-7.5 parts by weight. Support for the lower amount of 1.0 part can be found on page 5, line 12 of the specification. In addition, claims 1-11 were amended to place them in proper form.

In the Office Action, the Examiner rejected claims 1-11 under 35 U.S.C. §102(b) for being anticipated by "Asaki Chemical Industry Co. Ltd." on page 2 of the Office Action. Presumably he means JP 11-181199 (hereafter JP'199) although this is not set forth in the rejection and there is more than one Asahi Chemical Industry Co. Ltd. Japanese patent document cited in the ISR. Since this reference was cited as an X reference in the ISR, it is assumed the Examiner means this document. The Examiner also rejected claims 1-11 under 35 U.S.C. §103(a) for being obvious over JP'199 in view of JP 10-204173 (hereafter JP'173).

Attached for the Examiner's consideration are complete English translations of JP'199 and JP'173.

As noted above, independent claims 1, 6, and 11 claim an amount of ortho cresol based on 100 parts by weight of the polyphenylene ether of from 1.0 to 7.5 parts by weight.

JP'199 mentions ortho cresol in paragraph 7 as a comonomer with 2,6-dimethylphenol in a flame-retardant polyphenylene ether resin composition containing an organic phosphorous compound, but there is no disclosure of the amount of ortho cresol used.

As noted by the Federal Circuit in Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 43 USPQ 2d 1481 at page 1490 (Fed. Cir. 1997).

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to provide its existence in the prior art Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there.

See also M.P.E.P. §2131 where it states that:

"The identical invention must be shown in as complete detail as is contained in the . . . claim,"
Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236,
9 USPQ 2d 1913, 1920 (Fed. Cir. 1969).

Accordingly, it is submitted that claims 1-11 cannot be considered to be anticipated by JP'199, and its withdrawal as a ground of rejection of claims 1-11 under §102(b) is requested.

With respect to the rejection under §103(a), not only does JP'199 not disclose any amount of ortho cresol, but neither does JP'173. Reference is made to o-cresol in paragraph 22 (page 17), line 17 of the translation as a comonomer with 2,6-dimethylphenol, but no amount of the compound used is disclosed .

A feature of the present invention is the anti-dripping properties that are obtained upon burning of the claimed resin composition when the amount of ortho cresol is from 1.0 to 7.5 parts by weight. As can be seen from Table 2, with reference to Table 1 which shows the amounts of ortho cresol used in Examples 1-4, anti-dripping properties were exhibited in Examples 1-4 when the amount of ortho cresol ranged from 1 to 7 parts by weight. However, in Comparative Examples 1-3 where the composition contains only 100 ppm of ortho cresol, i.e., .01 parts by weight, (See page 17, line 18-19 of the specification), the composition did not exhibit anti-dripping properties.

Accordingly, the use of the claimed higher amounts of ortho cresol to obtain anti-dripping properties would not have been obvious to one skilled in the art. Moreover M.P.E.P. §2143 requires that to establish a *prima facie* case of obviousness the references relied on must teach or suggest all of the claimed limitations. Neither of the references teach or suggest the claimed range of ortho cresol, so it is submitted the claimed invention cannot be considered obvious over these references.

Moreover, this is consistent with the cited Ibe reference (U.S. Patent No. 4,788,277) where the suggested amount of ortho cresol for use with 2,6-dimethylphenol in a polyphenylene ether is only "about 1% or less." (See column 3, lines 43-47). There is no suggestion to use the higher amounts claimed or the benefits resulting therefrom.

Withdrawal of the rejection of claims 1-11 under §103 over JP'199 in view of JP'173 is therefore requested.

It is believed claims 1-11 are in condition for allowance.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Attachments: Complete English translations of JP'199 and JP'173.